

Atty. Dkt. No. 035451-0165 (3703.Palm)

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the reasons that follow. Because this response is being submitted within (2) months of the mailing date of the Office Action, a prompt Advisory Action is requested in the event that this reply is not found to place the present application in condition for allowance.

Claims 1, 3-11, 13-21, and 23-29 remain pending in this application. No claims are amended.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each claim.

**Claim Rejections - 35 U.S.C. §103(a)**

a. **Rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 based on Albukerk et al. in view of Colson et al.**

In Section 3 of the Office Action, claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 are rejected under 35 U.S.C. §103(a) as being anticipated by Albukerk et al. (U.S. Patent No. 5,929,848) in view of Colson et al. (U.S. Published Patent Application No. 2002/0078075).

With regard to claims 1, 11, and 21, Applicants respectfully submit that the combination of Albukerk et al. and Colson et al. is improper because there is no motivation or suggestion to combine these two references. Albukerk et al. provides no motivation for prioritizing the indexed information. Viewed as a whole, Albukerk et al. simply teaches using a "personal interpretive device" to identify an object and providing information about the object to a user who is in the vicinity of the object. Nothing in Albukerk et al. suggests that there is any need for prioritizing any information associated with the object using the personal interpretive device. The information is simply provided to the user (such as a museum visitor) from the personal interpretive device based on the object nearby. As to Colson et al., it does not provide any

Atty. Dkt. No. 035451-0165 (3703.Palm)

motivation to combine its own teachings with those of Albukerk et al., to arrive at Applicants invention recited in claims 1, 11, and 21. Viewed as a whole, Colson et al. teaches prioritizing data on a computer device for the purpose of synchronizing the computer device with another device, such as a PDA. However, nothing in Colson et al. suggests the desirability of combining its teaching of data prioritization during a synchronization process for a PDA with the personal interpretive device taught by Albukerk et al.

In response to Applicants' arguments filed on June 17, 2005, the Office Action states that "the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art." The Office Action goes on to state that "Albukerk teaches a personal interpretive device is included a storage for retrieving the information includes text data, graphic data, and audio data," and that "Colson teaches a system and program priority data for storing in the database." In the absence of any express suggestion in either Albukerk et al. and Colson et al. to combine these stated teachings, the Office Action appears to indicate that the requisite suggestion or motivation to combine these teachings may be found in the knowledge generally available to one of ordinary skill in the art by stating that "there is motivation to combine the teaching of Albukerk and Colson since the device can store and process the priority data." However, Applicants respectfully submit that an assertion of a general knowledge by itself that different types of data may be stored and processed does not provide the requisite suggestion or motivation to modify the personal interpretive device of Albukerk et al. to store and process the priority data of Colson et al., particularly when these references are viewed as a whole.

In fact, there are reasons found in the teachings of the Albukerk et al. and Colson et al. references themselves as to why one of ordinary skill in the art would not have been motivated to combine the respective teachings of these references to somehow arrive at the subject matter of claims 1, 11, and 21. For example, viewed as a whole, Colson et al. teaches prioritization only as part of a synchronization process between two platforms (i.e., the personal computer and PDA disclosed in Colson et al.). Albukerk et al., viewed as a whole, teaches using a personal interpretive device to identify an object and provide information about the object stored on the

Atty. Dkt. No. 035451-0165 (3703.Palm)

personal interpretive device to a user who is in the vicinity of the object. Albukerk et al. also teaches that the information stored on the personal interpretive device is updated "when the personal interpretive device 101 is stored in the storage base 113 and connected to the base computer." Col. 10, lines 7-10. To modify the teachings of Albukerk et al. to require a synchronization process between the personal interpretive device and the base computer for purposes of prioritizing information each time a different object is approached (i.e., when the personal interpretive device is not stored in the storage base) before providing the information to the user would require a substantial and unnecessary redesign of the system taught in Albukerk et al., and would change the principle of operation under which the system of Albukerk et al. was designed to operate. As such, there would be no suggestion or motivation to combine the teachings of Albukerk et al. and Colson et al..

Furthermore, Applicants respectfully submit that even if Albukerk et al. and Colson et al. were somehow properly combinable, the combination of Albukerk et al. and Colson et al. does not disclose, teach or suggest the prioritizing indexed data on a handheld computer or portable electronic device. While Albukerk et al. discloses the use of a personal interpretive device and Colson et al. discloses the use of a PDA, Albukerk et al. makes no mention of prioritized data in conjunction with the personal interpretive device (as acknowledged by the Office Action), and the prioritized information in Colson et al. is on the personal computer not on the PDA. The PDA taught by Colson et al. only receives the prioritized information in accordance with its priority. Therefore, not only is there no motivation for making the combination of references, the references together do not disclose or teach all of the claim limitations recited in independent claims 1, 11, and 21.

In further response to Applicants' arguments filed on June 17, 2005, the Office Action states that "there is nowhere in the claims that includes a PDA" and that "any device which can be moved by hand is "portable." Thus, the Office Action both impliedly asserts that Applicants have argued an unclaimed limitation and suggest that the personal computer in Colson et al., rather than the PDA, is both a portable electronic device. Applicants first submit that a careful

Atty. Dkt. No. 035451-0165 (3703.Palm)

review of their arguments filed on June 17, 2005 shows that their reference to a "PDA" refers to the teachings of Colson et al. as referenced on page 5 of the Office Action dated March 17, 2005, which cites "figure 1, PDA 46, col. 3 [0061]" in support of the assertion that Colson et al. teaches data prioritization. Applicants argued only that the "PDA" cited by the Office Action as being taught by Colson et al. does not perform data prioritization. Applicants further submit that claim 21 specifically recites a "handheld computer" rather than a "portable electronic device," and that as such, the statements in the Office Action regarding "portable" devices in general are inapposite.

Applicants also disagree with the broad characterization of the personal computer in Colson et al. as the portable electronic device of claim 1 or claim 11 based on a definition of the term "portable." Applicants' specification provides several examples of portable electronic devices (see, for example, paragraph [0013] of the specification), and also makes clear that the portable electronic device may be used to access information while being carried (see, for example, paragraphs [0001], [0020], [0023] etc), which would clearly exclude the personal computer of Colson et al. Furthermore, because the prioritization taught in Colson et al. is taught only as being performed by the personal computer and not on the PDA, any proposed modification of the system of Albukerk et al. to include data prioritization on the personal computer of Colson et al. would render the system of Albukerk et al. unsuitable for its intended purpose of allowing a user to access information about an object while carrying the personal interpretive device near the object.

In further response to Applicants' arguments filed on June 17, 2005, the Office Action states that "it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected resulted." However, by prioritizing data which has been indexed on a handheld computer or portable electronic device, Applicants have not merely made an old device portable or movable. Rather, Applicants have achieved the new result of enabling data prioritization based on adjacent resources or objects.

Atty. Dkt. No. 035451-0165 (3703.Palm)

Accordingly, Applicants respectfully submit that independent claims 1, 11, and 21 are therefore allowable and request that the rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 under 35 U.S.C. §103(a) be withdrawn.

b. **Rejection of claims 4-6, 14-15, 17, 24-25, and 27 based on Albukerk et al. in view of Colson et al. and further in view of Schulze et al.**

In Section 4 of the Office Action, claims 4-6, 14-15, 17, 24-25, and 27 are rejected under 35 U.S.C. §103(a) as being anticipated by Albukerk et al. in view of Colson et al. and further in view of Schulze et al. (U.S. Published Patent Application No. 2002/0078075).

Claims 4-6 depend from claim 1, claims 14-15 and 17 depend from claim 11, and claims 24-25 and 27 depend from claim 21. As stated above with regard to claims 1, 11, and 21, there is no motivation for making the combination of Albukerk et al. and Colson et al., and the references together do not disclose or teach all of the claim limitations recited in independent claims 1, 11, or 21. As to Schulze et al., it fails to make up for any of the above-mentioned deficiencies.

Because no proper combination of Albukerk et al. in view of Colson et al. and further in view of Schulze et al. discloses the subject matter of claim 1, 11, or, 21, and because claims 4-6 depend from claim 1, claims 14-15 and 17 depend from claim 11, and claims 24-25 and 27 depend from claim 21, Applicants respectfully submit that 4-6, 14-15, 17, 24-25, and 27 are patentable over the cited combination of references for at least the same reasons as the independent claims from which they respectively depend. Accordingly, Applicants respectfully request that the rejection of claims 4-6, 14-15, 17, 24-25, and 27 under 35 U.S.C. §103(a) be withdrawn.

**Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Atty. Dkt. No. 035451-0165 (3703.Palm)

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 11/21/2005

By Chad E. Bement

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 297-5554  
Facsimile: (414) 297-4900

Chad E. Bement  
Attorney for Applicant  
Registration No. 54,991

MILW\_1896114.1

- 11 -

Application No. 09/998,079